

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1-22 were previously canceled.

Claims 23 and 32 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 23-42 (20 claims) are now pending in this application.

The Office Action of September 20, 2004 and the references cited therein have been considered. In response to the rejections to the claims, the Applicant has amended independent claims 23 and 32 and further provide the following comments. As demonstrated, however, each of the rejections is believed overcome, with the application being placed in condition for allowance. Accordingly, reconsideration and allowance of this application is respectfully requested.

On page 2, the Examiner has objected to the claims. Specifically, the Examiner states that claims 27 and 35 have typographical errors in the fifth line of each claim. Further, the Examiner states that claim 42 is objected to because it depends on a canceled claim 20. In response, Applicant notes that the undersigned attorney and Examiner Tang had a telephone conversation on September 10, 2004 relative to the numbering of the claims as stated in the Office Action. Following that telephone conversation, the undersigned submitted on September 10, 2004 a substitute preliminary amendment correcting the claim numbering to the present claims 23-42. Also, in that substitute preliminary amendment, the undersigned corrected the typographical error in claim 27, changing the word "form" to the word "from". It is noted that claim 35 as submitted did not have a similar typographical error. With respect

to claim 42, Applicant submits that it is dependent from claim 32 and not 42 as assumed by the Examiner. Please note that the substitute preliminary amendment filed on September 10, 2004 corrected all of the discrepancies noted by the Examiner. For the convenience of the Examiner, a copy of the substitute preliminary amendment is enclosed. Accordingly, Applicant respectfully requests that the Examiner withdraw her objections to the claims as noted above.

On pages 2 through 7 of the Office Action, the Examiner has rejected claims 23-29, 31-37, 39 and 40 under 35 U.S.C. §102(e) as being anticipated by Butler II (USPN: 5,625,681). In the Office Action, the Examiner utilizes the language of the claims in the present application when referring to Butler.

Butler discloses a method and apparatus for telephone number portability (emphasis added). Butler teaches the portability of common format telephone numbers (column 3, lines 41-42) and teaches a mechanism by which the subscriber numbers are translated to provider numbers and provider numbers are translated to subscriber numbers (column 4, lines 29-33).

In response, Applicant has amended independent claim 23 and independent claim 32. Support for these amendments can be found in the specification as filed, on page 17, lines 12-14 and with respect to independent claim 23, on pages 17-20 and Figures 2 and 3. With respect to independent claim 32, support is provided on page 17, lines 12-14 and pages 20-23 of the specification and Figures 4 and 5. Applicant submits that the present application teaches switching of a subscriber station from a first telecommunication network to a second telecommunication network while retaining accessibility in the course of this "changeover" from the first telecommunication network to the second telecommunication network. The prevalent subscriber station is accessible virtually all of the time, without interruption, and can always set up connections itself. Further, it is also possible for the subscriber station to set up connections to other subscriber stations in both telecommunication networks. (See specification page 11, lines 3-23.)

In contrast, Butler teaches number portability and the mechanism of translation of subscriber numbers to provider numbers and provider numbers to subscriber numbers as

described above. In the Butler disclosure, the subscriber numbers are independent of the network structure but the provider numbers are dependent on the network structure. In contrast to what is taught by Butler, the present application, as described above and as disclosed and claimed in the present application, provides for a switching between the first telecommunication network and the second telecommunication network, and vice versa, despite a geographical change of the subscriber.

Applicant submits that Butler does not provide an initial storing of secondary routing information in a first telecommunication network with the secondary routing information being used for connection set up to the second telecommunication network via the connection point when the subscriber station is not present, as disclosed and claimed in the present application (specifically independent claims 23 and 32, as amended). Likewise, since dependent claims 24-31 and 33-42 depend either directly or indirectly from independent claims 23 and 32, respectively, they too are not anticipated by Butler. Accordingly, Applicant respectfully requests that the Examiner withdraw her rejection of the claims under 35 U.S.C. §102(e).

On pages 7-11, the Examiner has rejected claims 30, 38, 41 and 42 under 35 U.S.C. §103(a) as being unpatentable over Butler II in view of McGary, et al (USPN: 5,774,316). McGary discloses a ground fault detector for line powered telephone network.

Applicant reiterates his comments with respect to Butler herein as if fully set forth. Applicant submits that one ordinarily skilled in the art would not look to combine Butler with McGary for at least the reason that Butler is concerned with portability of telephone numbers and there is no teaching or suggestion or motivation to combine the teaching of Butler with McGary to obtain that which is disclosed and claimed in the present application.

Applicant submits that the Examiner's prior art analysis if the basis of the rejection is obviousness under 35 U.S.C. §103 must include evidence relevant to the finding of whether there is a teaching, motivation or suggestion to select and combine the references relied on as evidence of the obviousness.

Applicant submits that the Examiner is relying on hindsight in making the above obviousness rejection of the cited claims under 35 U.S.C. §103(a). Applicant believes that the Examiner is basing her rejection on the mere identification in the prior art of individual components of claimed limitations in the present application. Applicant believes that the Examiner is using the language of the present application claims and trying to fit them into the language of, primarily, the Butler reference. For example, the Examiner cites column 4, lines 30-49 in Butler as initially storing the secondary routing information in the first local exchange. The sections cited in Butler pertain to a mechanism for translating subscriber numbers and provider numbers and provider numbers translated to subscriber numbers which is not discussed or mentioned in the present application. Without evidence of a suggestion, teaching or motivation in the prior art to combine, simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability, which is the essence of hindsight.

As stated above, the Applicant has pointed out the differences in structure and functionality of the various elements cited by the Examiner in the various prior art patents combined by the Examiner in making her obviousness rejections. The Examiner has not made any showing of the teaching or instruction to combine the elements from the cited prior art patents. Applicant submits that, as stated above, the claims as amended are patentably distinct from the prior art cited by the Examiner and that one ordinarily skilled in the art would not be compelled to combine the elements cited by the Examiner to obtain that which is disclosed and claimed in the present application. The problem looked to be solved by Butler, namely the portability of telephone numbers, is not the same as the problem to be solved in the present application, namely, the switching from a first telecommunication network to a second telecommunication network in the shortest time possible, and therefore, one would not be compelled to look to Butler to solve the problem identified in the present application. Accordingly, one ordinarily skilled in the art would not look to Butler in the first instance, much less combine Butler with McGary to obtain that which is disclosed and claimed in the present application.

Accordingly, Applicant respectfully requests that the Examiner withdraw her rejection of the claims under 35 U.S.C. §103(a).

The prior art made of record but not relied upon has been reviewed.

Applicant has attempted to comment to the extent necessary to distinguish the claims over the prior art and to amend the claims to the extent necessary to distinguish the claims over the prior art but with the intent of not limiting the scope of the invention protection afforded by the patent laws or these claims, any further than absolutely necessary. It is respectfully submitted that each outstanding rejection has now been overcome and that each claim is in condition for allowance. Reconsideration and allowance is respectfully requested.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

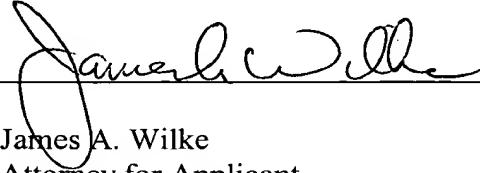
The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 12-17-04

By


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TITLE: METHOD FOR SWITCHING A SUBSCRIBER SET FROM A FIRST TELECOMMUNICATIONS NETWORK TO A SECOND TELECOMMUNICATION NETWORK

Inventor(s): LOBIG, Norbert
Appl. No.: 09/786,527

Dkt. No. 089339-0363
JAWI (9/10/04)

- Preliminary Amendment Transmittal (2 pgs.);
- Substitute Preliminary Amendment Under 37 CFR 1.115 (8 pgs.).

Due Date:
Date Filed:

Attorney Initials:
Insp. By:



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9/20/04